

## **REMARKS**

Claims 1, 3, 4, 6 and 12-15 are now in the case.

Initially, applicant requests that the Examiner correct an error appearing in the Office Action of September 20, 2004. On page 2 under "Detailed Action" appears the sentence: "This Office action is responsive to communication received 05/19/2004 - Request for Reconsideration." The date set forth in this sentence is incorrect. The date of the communication to which the Office Action is responsive is November 17, 2003, the date on which the Request for Reconsideration was filed in the U.S. Patent and Trademark Office (PTO).

This response of November 17, 2003 was apparently lost by the PTO. As the Examiner recalls, he contacted the firm of the undersigned attorney and requested another copy which was faxed to the Examiner on May 17, 2004 and which was also confirmed by facsimile to the Examiner on May 19, 2004. This latter date is thus not the date to which the present Office Action ought to refer. The present Office Action is instead responsive to the Request for Reconsideration which was filed November 17, 2003, not May 19, 2004. Valuable patent term has been lost because of the loss by the PTO of the timely response and the subsequent delay. The Examiner in the next Office Action is thus requested to delete reference to the incorrect date of May 19, 2004 and make reference to the correct response date of November 17, 2003 so that patent term lost due to the fault of the PTO can be regained.

Claims 1 and 12 stand rejected under 35 U.S.C. § 102(b) as anticipated by the patent to Thomson, of record. This rejection is respectfully traversed both as to claims 1 and 12 as well as to new independent claims 14 and 15. Thomson provides

three surface portions, i.e., an upper portion 39 that begins at point 38, a lower portion 41 which is tangent to the arc 35 at point 36, and an arcuate striking surface 35 between the upper and lower surface portions. Thus, in Thomson, the upper and lower portions are not in contact with each other at a boundary line (claim 14) or across the entire face surface at the boundary line (claim 15). Instead, the upper and lower portions are in contact with a middle curved portion 35. Similarly, Thomson does not teach or suggest, as set forth in claim 1, that its face surface is free of another face surface portion at said boundary line other than the recited upper and lower portions of the face surface. As noted above, the upper and lower portions of the face surface of Thomson contact a middle curved portion 35 on the surface of the club face.

Additionally, no sweet spot appears to be defined in Thomson. Nevertheless, assuming, arguendo, that a sweet spot exists where a perpendicular line from horizontal axis 37 intersects the face surface of head 19, if a boundary line is drawn at this spot, it would be within the middle curved surface 35. There would be the same roll radius above and below this boundary line, resulting in the failure of Thomson to meet the recitals of roll radii in the claims.

Thus, Thomson fails as an anticipatory reference for any of claims 1, 12, 14, and 15.

The repeated rejection of claims 4 and 13 based on Thomson in view of the patent to Reuter, Jr. of record is also respectfully traversed because Reuter, Jr. fails to correct the deficiencies of Thomson discussed hereinabove.

Claims 1, 3, 4, 6, 12, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Werner in view of Masghati, both of record. This rejection is

respectfully traversed because the proposed combination of references is contrary to the instructions of the MPEP, Section 2143, e.g., neither reference suggests the desirability of the claimed invention, and the proposed modification would render prior art unsatisfactory for its intended purpose.

Masghati describes the discovery that the true axis of rotation is substantially inclined from the vertical and lies in a plane which intersects the axis of the shaft (col. 5, lines 21-23). Masghati goes on to describe that the striking face 79 of the club is provided with both a convex bulge curvature and a convex roll curvature. There is no teaching that either curvature can be dispensed with or that portions of the curvature of the club face can be segregated into upper and lower portions and utilized apart from the Masghati invention. It is the entire club face that is important and necessary to attain the Masghati invention. As a result, no one skilled in the art would attempt to “borrow” a portion of the face of Masghati apart from the whole because to do so would render Masghati unsatisfactory for its intended purpose and be contrary to the MPEP mandate. As to the effect on Werner where the entire club face must now have a single curve based on Masghati, the principle of operation would be changed because the benefit of curving only the upper portion of the Werner club face would no longer be available.

Secondly, on page 4 of the Office Action, the Examiner compares the similarity of the attempted combination of Werner and Masghati with his position on Thomson, namely, that nothing in the claims precludes existence of more than one roll radius for either the upper or lower portions of the head. It appears from this observation the Examiner intends to have at least a third roll radius of the club face in the proposed

combination of Werner and Masghati. This rearrangement excludes all three independent claims 1, 14, and 15 because the presence of a third middle surface, as in Thomson, is outside of the scope of these three claims for the reasons discussed above regarding the Thomson patent.

Thirdly, the Examiner refers to a rejection in the previous Office Action of July 16, 2003 where two different disclosures of curvature in Masghati are used to set the curvatures of Werner, i.e., a roll radius of 305 mm or less for the upper portion and a roll radius of 310 mm or more for the lower portion. The portions of the Masghati patent on which the Examiner relies do not disclose Masghati's invention and appear to be contrary to Masghati's invention by relying on an incorrect location for the axis of rotation. Accordingly, it is submitted a skilled artisan would not select roll radii values for Werner's upper and lower portions based on the teachings of Masghati referenced by the Examiner. The resulting reworking of Werner is thus based on hindsight and one not to be found or suggested in the invention of either Werner or Masghati but only in the present invention. Thus, without resorting to the case law that was previously recited challenging the Examiner's approach, the Examiner's hindsight runs head on into the prohibitions of the MPEP recited above.

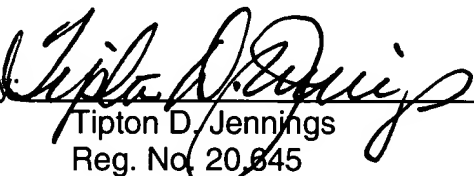
Early examination and allowance of claims 1, 3, 4, 6, and 12-15 are earnestly solicited.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

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